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09/382,702

08/24/1999

PETER ANTHONY HOCHSTEIN

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04/22/2010

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EXAMINER

BERHANE, ADOLF D

ART UNIT

PAPER NUMBER

2838

MAIL DATE

DELIVERY MODE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PETER ANTHONY HOCHSTEIN

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Appeal No. 2010-002029  
Application 09/382,702  
Technology Center 2800

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Mailed: April 22, 2010

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Before DALE M. SHAW, *Division 2 Support Administrator*.

ORDER REMANDING TO EXAMINER

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This application was electronically received by the Board of Patent Appeals and Interferences on December 14, 2009. Upon review of the application, it has been determined that a remand to Examiner, via the Office of the Director of the Technology Center, is necessary to consider the following issues and to take necessary corrective action.

EXAMINER'S ANSWER, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed August 28, 2009 under the heading "Response to Argument" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. Each grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure* (MPEP) §§ 1207.02 and 1207.03 (8<sup>th</sup> ed. Rev. 7, July 2008) for details.

A review of the Examiner's Answer finds a new ground of rejection that has not been provided the required heading "New Grounds of Rejection" and that does not include the approval of the TC Director or his/her designee.

Specifically, in response to the Appellant's arguments, the Examiner's Answer considers for the first time the Hochstein Declaration (filed on April 12, 2007) in the discussion of the rejection of claims 24, 37, 38, 41, 42, 46, 47, 49 and 50 under 35 U.S.C. 103(a) as unpatentable over Johnson, Applicant's Prior Art, and Hildebrand. Ans. 16-17. Therefore, a Replacement Examiner's Answer should be generated, fully duplicating the original Examiner's Answer, and this rejection should be designated as a New Ground of Rejection under 37 CFR 41.39(a)(2) so as to permit Appellant the option to either:

- 1) reopen prosecution under 37 CFR 41.39(b)(1), or

2) maintain the appeal under 37 CFR 41.39(b)(2).

### REPLY BRIEF

In light of the fact that a Replacement Examiner's Answer will be issued, the Reply Brief filed October 13, 2009 will not be considered as responsive to the forthcoming Replacement Examiner's Answer unless the Appellant responds in writing, explicitly requesting such consideration.

In addition, a review of the file finds that the Reply Brief filed October 13, 2009, includes new evidence.

In accordance with 37 CFR 41.41(a)(2):

A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence....

Therefore, in accordance with 37 CFR 41.39(b)(2), a reply brief accompanied by new evidence:

shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

Therefore, any reply brief accompanied by an amendment, affidavit or other evidence, as was the Reply Brief filed on October 13, 2009, will be treated as a request that prosecution be reopened before the Examiner. *See* MPEP § 1208 for details.

### CONCLUSION

Accordingly, it is

ORDERED that this application be returned to the Examiner:

1) to vacate the Examiner's Answer mailed August 28, 2009;

2) to generate a Replacement Examiner's Answer setting forth the correct Grounds of Rejection and to correct other sections of the Answer as may be required;

3) to include the approval of the TC Director or his/her designee for the New Grounds of Rejection;

4) to notify the Appellant that the Reply Brief filed on October 13, 2009 will not be considered as responsive to the Replacement Examiner's Answer unless Appellant responds in writing to the new Answer explicitly requesting such consideration;

5) to notify Appellant that any reply brief accompanied by new evidence will be treated as a request to reopen prosecution; and

6) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DMS/mls

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